

Application S/N 10/631,234
Amendment Dated: October 20, 2006
Response to Office Action dated: May 12, 2006

CE11265J1111

RECEIVED
CENTRAL FAX CENTER

OCT 20 2006

REMARKS/ARGUMENTS

Claims 1-3, 5-12 and 14-17 remain pending in the application, as claims 4 and 13 were previously canceled without prejudice. In the Office Action, claims 1-3, 6-12 and 15-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,987,332 to Gettleman, et al. (Gettleman) in view of U.S. Patent No. 5,995,500 to Ma, et al. (Ma). In addition, claims 5 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gettleman in view of Ma and further in view of U.S. Patent No. 6,070,070 to Ladue (Ladue).

Independent claim 1 has been amended to clarify that the method includes the step of permitting at least one of the set of callers to determine whether to terminate the first communications channel in response to the receipt of the user-recognizable notification. Independent claims 9 and 10 have been similarly amended. Support for the amendment can be found on page 18, line 22 to page 19, line 5. No new matter has been added in view of these amendments.

Gettleman simply mentions nothing about such a feature. In addition, the process described in Ma directly contradicts the claimed invention. In particular, Ma describes the MSC (12) instructing the mobile stations in direct communication with one another (i.e., first channel) to switch to indirect communication mode (i.e., second channel) when a call waiting signal is received from the network (see col. 10, lines 41-59). That is, the first communications channel is torn down and the call waiting signal is transmitted to the appropriate mobile station over the second channel without the user of the mobile station being given an opportunity to determine whether to terminate the first channel. Thus, the user of the switched mobile station faces the increased risk of a

Application S/N 10/631,234
Amendment Dated: October 20, 2006
Response to Office Action dated: May 12, 2006

CE11265JI111

dropped call or the possibility of incurring usage charges from a wireless carrier when the mobile station is switched to the second network-assisted channel without having a chance to decide whether to actually terminate the first channel.

In view of the above, Applicants submit that independent claims 1, 9 and 10 are patentable over the prior art. Applicants also believe that those claims that depend from these independent claims are patentable, both based on their dependencies on the independent claims and their patentability on their own. Reconsideration and withdrawal of the rejection of the claims is respectfully requested. Passing of this case is now believed to be in order, and a Notice of Allowance is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicants' attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Application S/N 10/631,234
Amendment Dated: October 20, 2006
Response to Office Action dated: May 12, 2006

CE11265JI111

The Commissioner is hereby authorized to charge any necessary fee, or credit any overpayment, to Motorola, Inc. Deposit Account No. 50-2117.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.
Law Department – MD 1610
8000 W. Sunrise Blvd.
Plantation, FL 33322

Customer Number: 24273

By: 

Larry G. Brown
Attorney of Record
Reg. No.: 45,834

Telephone: (954) 723-4295
Fax No.: (954) 723-3871